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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,620	12/27/2001	James W. Overbeck	3319.3 (02US2)	9519

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EXAMINER

NGUYEN, THONG Q

ART UNIT PAPER NUMBER

2872

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,620

Applicant(s)

OVERBECK, JAMES W.

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62-81 and 91-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62-81 and 91-97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/30/2006 has been entered.

Response to Amendment

2. The present Office action is made in response to the amendment filed on 10/30/2006. It is noted that in the amendment, applicant has amended claims 62 and 72. There is not any claim being added or canceled from the application. The pending claims 62-81 and 91-97 are examined in this Office action. Note that claims 1-61 were canceled in the amendment of 6/11/02 and claims 82-90 were canceled in the amendment of 1/21/05.

Election/Restrictions

3. Claim 62 is allowable. The restriction requirement between inventions, as set forth in the Office action mailed on 7/25/05, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claims 66 and 67, directed to a specific features of data collection and conversion system, are no longer withdrawn from consideration

because the claims requires all the limitations of an allowable claim. As a result of rejoin of the claims 66-67, all pending claims 62-81 and 91-97 are examined in this Office action.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 2872

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 62-81 and 91-97 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,201,639 in view of Alexay et al, Essay titled "Fluorescence scanner employing a Micro scanning Objective" (of record).

The device as claimed in claims 1-35 of the Patent '639 discloses a wide field of view scanner having a scanning mechanism supporting an objective lens and a mechanism for driving the scanning assembly. The features related to a driver, the detector in the form of a position element, light source, light detector, translation system for producing movement of the object and data processing system...as recited in present claims are disclosed as can be seen in Patent claims. The features related to the mirrors of the scanning assembly as claimed are disclosed in the Patent claims 2 and 7, and the constant of the light path is disclosed in the Patent claim 2. The focusing of the system as recited in present claims is disclosed in the Patent claim 23. The only feature missing from the device of the mentioned Patent claims is that they do not clearly state that the light reflected from the object and received by the detector system is fluorescent light. However, the use of a scanning microscope having an illuminating system

for providing light to excite a sample having fluorescent agents and a detecting system for receiving fluorescent light emitted from the sample is known to one skilled in the art as can be seen in the scanner provided by Alexay et al. For instance, in page 63, Alexay et al disclose a scanner for reviewing a reviewing a DNA sample supported by a microscope slide, in pages 64-65, Alexay et al disclose a scanner having an illuminating system having light source, excitation filter, dichroic beam splitter for providing light to excite the DNA sample, and the light emitted from the sample passed through the dichroic beam splitter and barrier filter is received by a detecting system. See also figure 1. Thus, it would have been obvious to one skilled in the art at the time the invention was made to utilize the scanning microscope as provided in Patent claims 1-35 to view and detect light from a DNA sample as suggested by Alexay et al for the purpose of observing/analyzing biological sample contained fluorescent agents.

Response to Arguments

6. The amendments to claims 62 and 72 and applicant's arguments filed on 10/30/06 have been fully considered and yielded the following conclusions.

First, the amendments to the claims are sufficient to overcome the rejection of claims 62-63, 68-69, 95 and 97 under 35 USC 102(b) over the art of Kimura, and the rejections of claims 62, 65, 68-71 and 97 under 35 USC 103(a) over the combination art of Kain et al, Nomura et al and Mathies et al.

Second, the amendments to the claims are sufficient to overcome the rejection of pending claims under the judicially created doctrine of obviousness-type double

Art Unit: 2872

patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,201,639 in view of Kimura. However, a review of Patent claims and the art of record has resulted that the pending claims are subjected to a rejection under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,201,639 in view of Alexay et al which rejection is provided in this Office action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

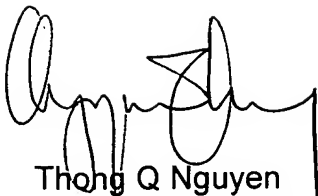
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/034,620

Page 7

Art Unit: 2872



Thong Q. Nguyen
Primary Examiner
Art Unit 2872
